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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,044	11/21/2003	Steven J. Smith	MNDSh-01006US0 MCF/BTW	5039
23910	7590	01/03/2008	EXAMINER	
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			DAILEY, THOMAS J	
			ART UNIT	PAPER NUMBER
			2152	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/721,044

Applicant(s)

SMITH ET AL.

Examiner

Thomas J. Dailey

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/23/2004</u>   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-59 are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-5, 11-13, 17-19, 25-27, 33-34, 41-42, 49-50, and 56-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 3, 11, 17, 25, recite, "the user information comprises an identification method." It is unclear how a user information can comprise a method, i.e. it should be identification information or means.
5. Claims 33, 41, 49, and 56, recite, "the identification method is a sender mail address." It is unclear how a method can be an address, i.e. a method should utilize an address not be an address.

6. Claims 34, 42, 50, and 57, recite, "the identification method is a digital signature."

It is unclear how a method can be a signature, i.e. a method should utilize a signature not be a signature.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 29-44 and 52-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirsch (US Pat. 6,546,416, cited in IDS dated 8/23/2004).
9. As to claim 29, Kirsch discloses a method for modifying mail filters, the method comprising:
- receiving an identifier for a user from a user system (column 3, lines 43-57);
  - checking the user system for the presence of a token, the token configured to initiate the processing of a petition for a sender to be added to a list of approved senders (column 3, lines 58-67, system checks for incoming challenge reply);
  - receiving the token (column 3, lines 58-67, challenge reply is received); and

processing the petition (column 3, lines 58-67, petition information is obtained from challenge reply and is processed).

10. As to claims 37 and 52, they are rejected by the same rationale set forth in claim 29's rejection.

11. As to claims 30, 38, and 53, Kirsch discloses requesting permission from the user to add the sender to the list of approved senders (column 3, lines 58-67).

12. As to claims 31, 39, and 54, Kirsch discloses adding a sender address to the list of approved senders (column 3, lines 58-67, if reply is valid, sender will be added to verified source address list).

13. As to claims 32, 40, and 55, Kirsch discloses the petition comprises an identification method (column 3, lines 43-57).

14. As to claims 33, 41, and 56, Kirsch discloses the identification method is a sender mail address (column 3, lines 43-57).

15. As to claims 34, 42, and 57, Kirsch discloses the identification method is a digital signature (column 3, lines 43-57).

16. As to claims 35, 43, and 58, Kirsch discloses the token includes the petition (column 3, lines 58-67, challenge reply includes petition information (i.e. the data necessary to add the sender to the verified source address list).
17. As to claim 36, 44, and 59, Kirsch discloses the petition includes a reference to a petition location (column 7, lines 22-35, a challenge reply (email containing the petition) is received and evaluated, inherently a reference to the location of the petition is given as the challenge reply is actively evaluated).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 3-9, 11-15, 17-23, 25-28, 45-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch.
20. As to claim 1, Kirsch discloses a method for modifying mail filters associated with a user of a mail system, the method comprising:

receiving a request, the request including user information (column 3, lines 43-57, a challenge email (request) is issued to an unverified address);

generating a petition from the user information, the petition comprising a request for a sender to be added to a list of approved mail senders, the list associated with the user (column 3, lines 58-67, unverified address petitions to have address added to verified address list by responding to the challenge email); and

transmitting a token storing the petition to the user (column 3, lines 58-67).

But, Kirsch does not disclose that said request is a subscription request, rather it is a challenge email in response to an email from an unverified source. However, one of ordinary skill in the art would view it as obvious that the challenge email could be viewed as a subscription request insomuch as the user is requesting to verify that an address is legitimate and subscribing to receive emails from that address. In this case, the challenge email need not be sent as a response to an incoming email, but can simply be sent before such an event to verify the address. Such a modification would be obvious to one of ordinary skill in the art, as it just eliminates the need for an incoming email and allows the Kirsch's system to actively verify address, rather than doing it reactively.

21. As to claim 7, Kirsch discloses a method for modifying mail filters associated with a user of a mail system, the method comprising:

receiving a request, the request including user information (column 3, lines 43-57, a challenge email (request) is issued to an unverified address);

generating a petition from the user information, the petition comprising a request for a sender to be added to a list of approved mail senders, the list associated with the user (column 3, lines 58-67, unverified address petitions via a challenge reply (a petition) to have address added to verified address list by responding to the challenge email); and

transmitting to the user a token storing a reference to a location of the petition (column 7, lines 22-35, a challenge reply (email containing the petition) is received and evaluated, inherently a reference to the location of the petition is given as the challenge reply is actively evaluated).

But, Kirsch does not disclose that said request is a subscription request, rather it is a challenge email in response to an email from an unverified source. However, one of ordinary skill in the art would view it as obvious that the challenge email could be viewed as a subscription request insomuch as the user is requesting to verify that an address is legitimate and subscribing to receive emails from that address. In this case, the challenge email need not be sent as a response to an incoming email, but can simply be sent before such an event to verify the address. Such a modification would be obvious to one of ordinary skill in the art, as it just eliminates the need for an incoming email and allows the Kirsch's system to actively verify address, rather than doing it reactively.



22. As to claims 15 and 45, they are rejected by the same rationale set forth in claim 1's rejection.

23. As to claim 21, it is rejected by the same rationale set forth in claim 7's rejection.

24. As to claims 3, 11, 17, and 25, Kirsch discloses the user information comprises an identification method (column 3, lines 43-57).

25. As to claims 4, 12, 18, and 26, Kirsch discloses the identification method includes an origin electronic mail address for the sender (column 3, lines 43-57).

26. As to claims 5, 13, 19, and 27, Kirsch discloses the identification method includes a digital signature (column 3, lines 43-57).

27. As to claims 6, 14, 20, 28, and 51, Kirsch discloses the user information comprises a user identifier (column 3, lines 43-57).

28. As to claims 8 and 22, Kirsch discloses receiving a request for the petition from a party maintaining the list of approved mail senders and transmitting the petition in response to the request for the petition (column 3, lines 58-67, computer sends challenge email soliciting a petition to be added to verified source address list).

29. As to claim 9 and 23, Kirsch discloses including authentication credentials in the token and receiving authentication credentials with the request for the petition (column 3, lines 58-67).

30. As to claim 46, Kirsch discloses the token includes the petition (column 3, lines 58-67, challenge reply includes petition information (i.e. the data necessary to add the sender to the verified source address list).

31. As to claim 47, Kirsch discloses the token includes a reference to a petition location (column 7, lines 22-35, a challenge reply (email containing the petition) is received and evaluated, inherently a reference to the location of the petition is given as the challenge reply is actively evaluated).

32. As to claim 48, Kirsch discloses the petition comprises an identification method (column 3, lines 43-57).

33. As to claim 49, Kirsch discloses the identification method is a sender mail address (column 3, lines 43-57).

34. As to claim 50, Kirsch discloses the identification method is a digital signature (column 3, lines 43-57).

35. Claims 2, 10, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch, as applied to claims 1, 7, 15, and 21, in view of what is well known in the art.

36. As to claims 2, 10, 16, and 24, Kirsch does not explicitly disclose the token is a cookie. However, Official Notice (see MPEP ' 2144.03 Reliance on "Well Known" Prior Art) is taken one of ordinary skill in the art at the time of the invention would view it as an obvious modification of Kirsch to utilize a cookie to store the petition to the user, as a cookie is a common means to organize data in the art.

### ***Conclusion***


37. For additional prior art made of record and not relied upon and considered pertinent to applicant's disclosure see attached Notice of References Cited, Form PTO-892.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.

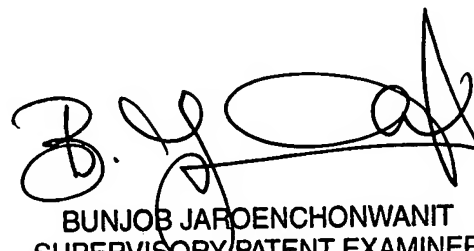
39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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